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10/054,539

10/25/2001

Benjamin J. Parker

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SPRINT COMMUNICATIONS COMPANY L.P.

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OVERLAND PARK, KS 66251-2100

EXAMINER

STRANGE, AARON N

ART UNIT

PAPER NUMBER

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BENJAMIN J. PARKER, SHANE R. WERNER,
CHARLES DIAZ, and TERRY M. FREDERICK

Appeal 2007-3486
Application 10/054,539
Technology Center 2100

Decided: July 17, 2008

Before ANITA PELLMAN GROSS, MAHSHID D. SAADAT,
and KEVIN F. TURNER, *Administrative Patent Judges*.

TURNER, *Administrative Patent Judge*.

ORDER REMANDING TO THE EXAMINER

This is an Order remanding the application to the Examiner. Based on our initial review of the application involved in this appeal and its prosecution history, the status of all of the pending claims is unclear. As discussed below, further action by the Examiner is necessary to allow for this appeal to be considered.

Claims 1-15 are pending and stand rejected based on the grounds of rejection listed below:

Claims 1-3, 8, 10, and 11 stand rejected under 35 U.S.C. § 103(a) over Zhang¹ and RAD;²

Claims 4-6 and 12-14 stand rejected under 35 U.S.C. § 103(a) over Zhang, RAD, and Li;³

Claims 7 and 15 stand rejected under 35 U.S.C. § 103(a) over Zhang, RAD, and Brown;⁴ and

Claim 9 stands rejected under 35 U.S.C. § 103(a) over Zhang, RAD, and Bero⁵.

In Appellants' Appeal Brief, filed January 30, 2006, claims 1-15 are acknowledged as pending and rejected (App. Br. 2), but only the first ground of rejection, the rejection of claims 1-3, 8, 10, and 11, is indicated as requesting review (App. Br. 5). Only that ground of rejection and its subject claims are discussed, but the failure "to establish a case of prima facie obviousness of any of claims 1-15," is also alleged. (App. Br. 7). The Examiner acknowledges the other applied grounds of rejection, (Ans. 3), but only discusses the first ground of rejection and responds to Appellants' arguments thereto. Appellants' Reply Brief merely responds to the Examiner's findings and arguments, with respect to the first ground of

¹ U.S. Patent No. 6,119,160

² RAD Data Communications, "DNS," 5/5/1999, Web Page, Archived by the Internet Archive Wayback Machine, Available at: <http://web.archive.org/web/19990505010206/http://www.rad.com/networks/1998/dns/main.html>

³ U.S. Patent No. 6,119,165

⁴ U.S. Patent No. 6,732,179

⁵ U.S. Patent No. 6,769,031

rejection, and reiterates that there has been a failure “to establish a case of prima facie obviousness of any of claims 1-15.”

In both the Appeal and Reply Briefs, Appellants did not expressly state that claims 4-7, 9, and 12-15 have been withdrawn from appeal. Appellants have only discussed claims 1-3, 8, 10, and 11 and their rejection, indicating that that particular rejection is the ground of rejection to be reviewed. (App. Br. 5). In addition, Appellants have not cancelled claims 4-7, 9, and 12-15 through amendment, nor have they withdrawn those claims through an express or implied statement. Since it appears that Appellants have not appealed claims 4-7, 9, and 12-15 and have not challenged the Examiner’s rejection of those claims, we treat these claims as withdrawn from the appeal.

If upon the filing of an Appeal Brief, the Applicants limits the claims to be considered on appeal, then it is the practice of the Patent and Trademark Office to treat the claims not pursued in the Appeal Brief as having been withdrawn from the appeal. *See, Manual of Patent Examining Procedure*, § 1215.03 (8th ed. Rev. 6, Sept. 2007). When Applicants no longer wish to pursue in the Appeal Brief rejected claims which were appealed in the notice of appeal, the Applicants should file an amendment canceling any claims which the Applicants no longer wish to pursue.

Accordingly, it is ORDERED that the application is returned to the Examiner to:

- (1) enter a paper canceling claims 4-7, 9, and 12-15, per MPEP § 1215.03, and
- (2) take such further action as may be appropriate.

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Upon entry of the paper, the application should be returned to the Board for consideration of the appeal on its merits as to remaining claims 1-3, 8, 10, and 11.

This remand to the Examiner pursuant to 37 C.F.R. § 41.50(a)(1) is *not* made for further consideration of a rejection. Accordingly, 37 C.F.R. § 41.50(a)(2) does not apply.

REMANDED

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